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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,699	02/01/2001	Ichiro Fujita	1614.1122	3086

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EXAMINER
PORTER, RACHEL L

ART UNIT	PAPER NUMBER
3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/774,699	FUJITA, ICHIRO
	Examiner	Art Unit	
	Rachel L. Porter	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 April 2007*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5-8, 10 and 12* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5-8, 10 and 12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/28/06*.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

Notice to Applicant

1.   This communication is in response to the amendment filed 4/24/07. Claims 5-8,

10 and 12 are pending.

Information Disclosure Statement

2.   The information disclosure statement (IDS) submitted on 11/28/06, has been

considered by the examiner.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claims 5-8, 10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

It is unclear to the Examiner what statutory class or type of device the claimed

"parts" (e.g. computer storage part, insurance request part, quote estimating part) are

intended to cover. In particular, it is unclear how the recited "insurance request part" is·

distinct from the insurance terminal. It is not clear whether these "parts" are intended to

be software modules or if applicant is intending to invoke some sort of "means"

language.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 5-7, 10, and 12 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Suliman, JR (US 2001/0053980 A1) in view of Flickinger et al (US

2001/0025245 A1).

[claim 5]   Suliman discloses a computer system for mediating between at least one

user terminal, at least one manufacturer terminal, and at least one insurer terminal via a

network, said system comprising:

- a first computer storage part in which purchase information related to products

  possessed by at least one user is stored; (par. 37, 43, 55—e.g. consumer acct.)

- a second computer storage part in which at least an identifier of a product and

  guarantee information related to said product are stored for each product

  available from said at least one manufacturer; and (par. 34,37-38)

Suliman does not expressly disclose:

- an insurance request part which sends request data for insurance on at least one product to the insurer terminal, wherein the request data for insurance includes first data on the at least one product, which is specified by a user terminal in said first computer storage, and second data on the at least one product, related to the product data, which is based on the information from the manufacturer stored in said second computer storage.

Flickinger discloses a system further comprising :

- an insurance request part which sends request data for insurance on at least one product to the insurer terminal, wherein the request data for insurance includes first data on the at least one product, which is specified by a user terminal, and second data on the at least one product, which is based on the information from the manufacturer. (par. 53-55, 65-68)

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to combine product registration using information from the user and manufacturer with the insurance process. As suggested by Flickinger, one would have been motivated to combine these features to provide the insurer with an accurate asset record for the insured (par. 67) and to facilitate the claims process by providing the insurer with ready access to required information (par. 55) .

[claim 6] Suliman and Flickinger disclose the system of claim 5 as explained in the rejection of claim 5. Furthermore Suliman discloses a system stores and retrieves the following information for product registration: at least a number of years used, year and month of purchase and maintenance of the product. (par. 37)

[claim 7] Suliman and Flickinger discloses the system of claim 5 as explained in the rejection of claim 5, but does not disclose that the insurance request part sends information for collectively insuring a plurality of products possessed by the user with a single insurance contract. Flickinger discloses a system wherein the user requests to collectively insure a plurality of products possessed by an individual (i.e. the user) with a single contract, as part of an umbrella policy. (par. 53) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to combine the teachings of Suliman with the teachings of Flickinger to allow the user to collectively insure a plurality of products possessed by him/her with a single contract. As suggested by Flickinger, one would have been motivated to include this feature to facilitate the underwriting process and insure that the insurance company has an accurate record of the individual's assets, with minimum effort on the part of the individual/purchaser. (par. 53)

[claim 10] Suliman discloses a method of mediating between at least one user terminal, at least one manufacturer terminal, and at least one insurer terminal over a network, said method comprising:

- receiving purchase information related to products possessed by at least one user; (par. 37, 43, 55)

- storing said purchase information in a first computer storage part; and (par. 37, 43, 55)

- first data on the at least one product, which is specified by a user terminal from purchase information stored in said first computer storage part, (par. 37, 55)

- wherein said second computer storage part stores at least an identifier of a product and guarantee information related to said product for each product available from said at least one manufacturer. (par. 34,37-38)

Suliman does not disclose a method comprising the step of requesting data for insurance.

Flickinger discloses a method further comprises a method further comprising:

- o requesting data for insurance on at least one product to the insurer terminal, wherein the request data for insurance includes first data on the at least one product from purchase information and second data on the at least one product, which is based on the information from the manufacturer (par. 53-55, 65-68)

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to combine product registration using information from the user and manufacturer with the insurance process. As suggested by Flickinger, one would have been motivated to combine these features to provide the insurer with an accurate asset record for the insured (par. 67) and to facilitate the claims process by providing the insurer with ready access to required information (par. 55) .

[claim 12]   Claim 12 repeats the subject matter of claim 10 a computer readable medium storing instructions, which cause a computer to perform the underlying method, recited in claim 10. As the underlying process has been shown to be fully disclosed and computer implemented by the teachings of Suliman and Flickinger in the above rejection of claim 10, it is readily apparent that the Suliman and Flickinger references include computer readable medium with instructions to cause a computer to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claim 10 and incorporated herein.

7.   Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suliman and Flickinger as applied to claim 5 above, and further in view of Lockwood.
[claim 8]   Suliman and Flickinger disclose the system of claim 5 as explained in the rejection of claim 5. Flickinger further discloses that the system includes an "E-broker that allows users to purchaser shop for a plurality of vendors that meet their parameters

for a service (par. 74). However, Suliman and Flickinger do not disclose wherein said insurance request part further comprises:

- a quote estimate part requesting a quote estimate from a plurality of insurers; and a sign-up part sending a sign-up instruction to the insurer selected by the user to make a contract for insurance.

Lockwood teaches a system which receives estimates/quotes from a plurality of insurers and which prepares a contract for insurance with the selected insurer. (col. 2, lines 8-19; col. 5, lines 44-col. 6, line 32) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Suliman and Flickinger in combination with the teaching of Lockwood to include gathering estimates from a plurality of insurers and to prepare a contract for insurance with the selected insurer. As suggested by Lockwood, one would have been motivated to include these features to allow the prospective insured to gather quotations from various institutions quickly and easily, and to compare quotations at leisure or obtain a policy on the spot. (col. 3, lines 33-37)

Response to Arguments

8.   Applicant's arguments filed 4/24/07 have been fully considered but they are not

persuasive.

Applicant's arguments with respect to the references have been considered but

are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-

6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RP

RP

C. LUKE GILLIGAN
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